

IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Peter Schöttler GmbH

Examining Attorney:

Mark: SCHÖTTLER

Pamela Y. Willis

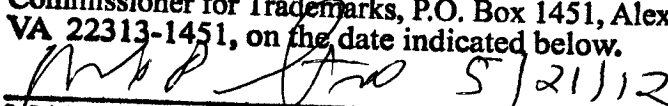
Serial No.: 79/092,036

Law Office 106

Filed: September 20, 2010

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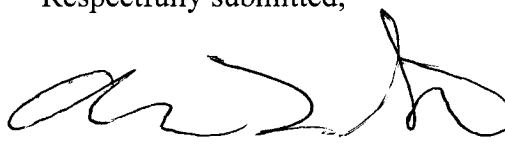
TRANSMITTAL OF REPLY BRIEF

Enclosed for filing please find the following items:

1. Reply Brief (9 pages)
2. Table of Cited Authorities (1 page)

Respectfully submitted,

Dated: 5/21/12



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05-24-2012

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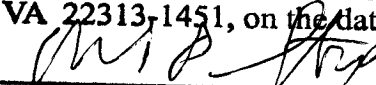
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REPLY BRIEF

This Reply Brief is being filed in response to the Examining Attorney's Appeal Brief dated May 2, 2012 ("Examiner's Brief"), in connection with the pending Appeal of the above-identified Trademark Application.<sup>1</sup>

Starting at the fourth page of the Examiner's Brief, the Examiner responds to the arguments set forth by Applicant in its Appeal Brief. Applicant respectfully disagrees with the Examiner for the reasons to be discussed as follows.

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<sup>1</sup> Applicant advises the TTAB that on November 10, 2011, it filed a United States Domestic Application to register the mark SCHÖTTLER on the Principal Register. This Application was assigned Serial Number 76/709,705, and is currently pending before the Patent and Trademark Office. In an Official Action dated March 6, 2012, the Examiner assigned to this Application initially refused registration of the mark on the Principal Register on the grounds that it is primarily merely a surname. However, the evidence relied upon by that Examiner in support of the refusal essentially duplicates the evidence relied upon by the Examiner in the present Application currently before the Board – primarily, a *de minimus* number of nationwide telephone directory listings. Thus, two separate Examiners in two separate Applications have failed to locate sufficient evidence to meet the burden of proof to refuse registration as primarily merely a surname.

Applicant initially notes that at page 11 of its Appeal Brief, the “rule of doubt” was discussed. Specifically, Applicant noted that U.S. Patent & Trademark Office (“USPTO”) policy requires that any doubt as to whether a mark is primarily merely a surname be resolved in favor of the Applicant, and that the mark be published for opposition. TMEP § 1211.01; *see also In re Benthin Mgmt. GmbH*, 37 U.S.P.Q.2d 1332, 1334 (T.T.A.B. 1995). The Examiner has completely failed to respond to this argument. While Applicant submits that there is no reasonable doubt that its mark will not be perceived as primarily merely a surname by the relevant American consuming public, it is nonetheless entitled to registration on the Principal Register under the rule of doubt, assuming arguendo, that any doubt exists based upon all of the evidence of record in connection with this Appeal.

Applicant also notes that the burden of proving that a mark’s significance is primarily merely a surname rests squarely on the USPTO. *See* Appeal Brief, p. 4; *see also e.g., In re Standard Elektrick Lorenz Aktiengesellschaft*, 371 F.2d 870, 873, 152 U.S.P.Q. 563 (C.C.P.A. 1967). In determining significance of a mark as primarily merely a surname, it is the American public’s perception that must serve as the guiding light. *See In re Kahan & Weisz Jewelry Mfg.*, 508 F.2d 831, 184 U.S.P.Q. 421 (C.C.P.A. 1975) (“ . . . the correct resolution of the issue can be made only after the primary significance of the mark to the purchasing public is determined . . . .”); *see also* Appeal Brief, p. 9.

Applicant additionally notes that while the Examining Attorney attempts to refute Applicant’s assertion that “[t]ypically, an Examiner is required to demonstrate ‘an unusually large number’ of telephone directory listings of the mark as a surname to carry the burden of proof” (Appeal Brief, p. 4-5), the Examiner does not dispute that her showing of telephone directory entries is *de minimus* in view of the overall population of the United States. *See* Appeal

Brief p. 5 (noting that Examiner only cites “at least 100” entries of the name “SCHÖTTLER” in a nationwide telephone directory, noting that Applicant submitted evidence that the population of the United States exceeds 310 million people, and submitting that 100 listings is therefore *de minimus*). Nor does the Examining Attorney dispute Applicant’s submission that at least some of the telephone entries cited by the Examiner appear to be duplicative. *See* Appeal Brief, p. 5 FN 2.

The Examiner asserts at the fifth and sixth pages of the Examiner’s Brief that, “the examining attorney argues that there is no rule as to the kind or amount of evidence necessary to make out a prima facie showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis.” While the Applicant agrees that cases must be determined based on their specific facts, rare surnames typically *are* registrable unless supplemental evidence of record overcomes the rarity of a surname. In fact, the Applicant distinguished the cases cited by the Examiner for the proposition that rare names can be refused registration.<sup>2</sup> *See* Appeal Brief, p. 7-9. Namely, in the cases relied upon by the Examiner, the TTAB was particularly impressed with the quantity of LEXIS/NEXIS hits using the mark as a surname notwithstanding a dearth of telephone directory entries. Here, the Examiner has not provided any evidence of LEXIS/NEXIS hits showing the mark used as a surname. The Examiner purports to cite supplemental evidence on the sixth page of the Examiner’s Brief. The cited “supplemental evidence” amounts to negative dictionary evidence, evidence of “real world” usage of the mark as a surname, and evidence that the proposed mark has no other meaning than as a surname. *See* Examiner’s Brief, p. 6. Initially, Applicant submits that the third category of evidence cited by the Examiner, namely, “evidence that the proposed mark has no other meaning than as a

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<sup>2</sup> As discussed on p. 6, *Infra*, the Examiner has failed to address or rebut the Applicant’s arguments distinguishing the caselaw relied upon by the Examiner.

surname”, is duplicative of the first two categories of evidence cited by the Examiner, and thus is not a separate third category.

Regarding the Examiner’s evidence of “real world” usage of the mark as a surname, the Examiner identifies merely one profile of one individual with the surname “Schöttler”, which individual appears to reside in Munich, Germany. *See* Examiner’s Brief, p. 6., note 2. Applicant asserts that that evidence of a single German resident with the surname “Schöttler” does not provide sufficient supplemental evidence to overcome the dearth of telephone directory entries to meet the Examiner’s heavy burden of proof to establish, without doubt, that the mark will be recognized as primarily merely a surname by the relevant contemporary American consuming public. *See* Appeal Brief, p. 11 (discussing USPTO policy requiring doubt to be resolved in favor of Applicant).

Next, Applicant addresses negative dictionary evidence, the second category of evidence cited by the Examiner as “supplemental evidence”, in her attempt to overcome the dearth of telephone directory entries. *See* Examiner’s Brief, p. 6, note 1. Applicant submits that a lack of negative dictionary evidence is not sufficient to meet the heavy burden of proof to deny registration on the grounds that the mark will be perceived by the contemporary American purchasing public as primarily merely a surname. Applicant asserts that the surname “Schöttler” is so rare in the United States (as shown by the dearth of telephone directory entries and lack of any LEXIS/NEXIS hits provided by the Examiner) that the mark will be perceived as fanciful, such as GOOGLE® is to an internet search company. A fanciful term, by definition, has no dictionary meaning.

On the sixth page of the Examiner’s Brief, the Examiner submits that, “[t]hough the listings do not show thousands of usages of ‘SCHÖTTLER’ used as a surname, the evidence

clearly shows that the mark *is* used as a surname.” Applicant submits that the Examiner’s burden is not to establish that the mark is used as a surname, but rather, the Examiner’s burden is to prove that the primary significance of the mark, as perceived by the contemporary American purchasing public, is a surname. *See In re Kahan*, 508 F.2d 831, 184 U.S.P.Q. 421; *see also* Appeal Brief, p. 9. Usually, this burden is met with a showing that the surname is common within the U.S., because a common surname would be likely to be understood by the relevant public as a surname, and not as a fanciful mark. *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION §13.30 (4th Ed. 2011) (hereinafter “MCCARTHY”) (“if the name is rare, purchasers are not likely to regard the word as a surname, because they have never seen the word so used.”). Applicant respectfully submits that the evidence of record, which consists primarily of *de minimus* telephone directory entries, negative dictionary evidence, and one German resident’s online profile, do not satisfy the Examiner’s burden that this rare surname will be perceived by the contemporary American purchasing public as primarily merely a surname.

On the seventh page of the Examiner’s Brief, the Examiner appears to attempt to place the burden on the Applicant to show that the mark, albeit rare, is not a surname. The Examiner states, “Although applicant’s arguments seek to distinguish the case law regarding ‘rare’ surnames, applicant has not provided any evidence to establish that the mark is *not* a ‘rare’ surname.” Examiner’s Brief, p. 7. Applicant respectfully submits that the burden is, in fact, on the Examiner to prove that the mark will be recognized by the contemporary American purchasing public as primarily merely a surname. The burden is not on the Applicant to prove that the mark is not recognized by the consuming public as primarily merely a surname, although Applicant submits that it has, in fact, done so by demonstrating that use of the mark as a surname

is so rare in the United States that it will be perceived as fanciful, not as primarily merely a surname. Nonetheless, Applicant respectfully submits that the Examiner has not met her initial burden to show that the rare surname will be perceived by the American public as primarily merely a surname.

Furthermore, Applicant respectfully notes that although the Examiner acknowledges that, “. . . applicant’s arguments seek to distinguish the case law regarding ‘rare’ surnames . . .” (seventh page of Examiner’s Brief), the Examiner does not address the specific arguments Applicant set forth distinguishing the cases cited by the Examiner in her refusal to register the mark. *See* Appeal Brief, p. 7-9. In particular, Applicant argued that the cases cited by the Examiner to support her conclusion that the mark is unregistrable in spite of its rarity as a surname are inapposite. Applicant further argued that rare surnames have been deemed unregistrable in special cases, namely, cases where the mark is combined with additional terms that elucidate the surname significance (i.e., “MD” or “et fils”, which translates to “and sons”), cases where media attention or publicity have brought to light the mark’s surname significance, and cases where the name, by its very structure, would be recognized only as a surname. *See* Appeal Brief, p. 7-10. Applicant concluded that none of the exceptions for denying registration of rare surnames apply here. *See id.* The Examiner failed to address these arguments.

On the seventh page of the Examiner’s Brief, the Examiner discusses the fact that the Applicant’s founder had the name “Peter Schöttler”. The Examiner asserts that “[g]iven that the founder’s surname is the same as the proposed mark, consumers would perceive that the mark SCHÖTTLER, as it identifies goods and services emanating from a company that uses this term as a surname, is itself a surname.” Examiner’s Brief, p. 7. Applicant acknowledges that *one* factor to be considered in determining the contemporary American consuming public’s

perception of a mark is whether the mark is the surname of someone associated with the Applicant. However, Applicant submits that the Examiner has presented no evidence of record establishing how a contemporary American consumer would even know that the Applicant company was founded by an individual named Peter Schöttler in Germany over 170 years ago.

Applicant agrees with the Examiner that registrability must be determined on a case-by-case basis, and “the entire record is examined to determine the surname significance of a term.” *See* Examiner’s Brief, p. 6. In the present case, Applicant’s company was founded over 170 years ago in Germany, and there are currently no individuals associated with the Applicant having the name Peter Schöttler. *See* Appeal Brief, p. 4., note 1; *see also* Examiner’s Brief, p. 7. Applicant submits that Applicant’s founding outside of the U.S. so many years ago is of questionable relevance as to the perception of the contemporary American consuming public regarding the primary significance of the mark.

Applicant further submits that the cases relied upon by the Examiner merely acknowledge that one factor to be considered is whether anyone connected to the Applicant has the mark as a surname, and do not indicate that this factor is more significant or probative than other factors. As noted, Applicant does not dispute that this is one factor to be considered in the analysis of the primary significance of a mark. Rather, Applicant argues that the specific facts regarding the founding of Applicant’s company have minimal bearing on the contemporary American consuming public’s perception of this mark. Further, Applicant submits that other factors, in particular, the rarity of the mark, weigh against denying registration of the mark, particularly in light of the USPTO policy requiring publication of the mark for opposition purposes where doubt exists as to the public perception of the mark.



On the eighth page of the Examiner's brief, the Examiner asserts that "Trademark Act Section 2(e)(4) makes no geographic limitations on the origin of the surname that appears in the marks." Applicant agrees with this proposition. However, the true issue to be determined is the perception of the contemporary American consuming public, and Applicant asserts that the foreign origin of a rare surname is relevant to the perception of the mark. The Examiner refers to telephone directory entries, and submits, "[s]ince the proposed mark is a surname of individuals living in the U.S., the American public would perceive it as a surname." *See* Examiner's Brief, p. 8. However, Applicant argues that if a surname is rare and of foreign origin, "purchasers are not likely to regard the word as a surname, because they have never seen the word so used." MCCARTHY §13.30. As fully discussed in the Appeal Brief, the telephone directory listings in the United States relied upon by the Examiner can only be considered *de minimus*, and therefore of limited evidentiary value on the perception of the mark.

On the ninth page of the Examiner's Brief, the Examiner attempts to rebut Applicant's arguments that the mark does not have the look and feel of a surname. In response to the Applicant's assertion that "the American consumer is fairly unfamiliar with words and names containing the letters 'SCH' and 'Ö', which are uncommon in the English language. Accordingly, the American consumer is unlikely to recognize the mark 'SCHÖTTLER' at all, let alone as a surname." (Appeal Brief, p. 11), the Examiner summarily states, "there are a number of surnames used in the United States that begin with the letters 'Sch'. In addition, many surnames used and heard in the United States contain accent marks. Given that many surnames used in the United States contain similar letter sequences as the proposed marks, and also contain accents, the American public would in fact perceive 'SCHÖTTLER' as a surname." (Examiner's

Brief, p. 9). The Examiner has introduced no evidence of record in support of her statement, which is therefore purely conclusory, and fails to rebut Applicant's arguments.

The Examiner's Conclusion, on the ninth page of the Examiner's Brief, asserts that the "record reflects that primary *usage* of the term 'SCHÖTTLER' is as a surname." (emphasis added). This misses the point, since it is the public's perception of the mark which is the real issue to be determined. Applicant submits that the surname is so rare and foreign to the relevant consuming public that it will not be perceived to be primarily merely a surname.

### **CONCLUSION**

Applicant submits, based upon all evidence of record in its totality, that the Examiner has failed to establish that the contemporary American consuming public will perceive the mark as primarily merely a surname. Even viewing the Examiner's evidence in the most favorable light, Applicant is nonetheless entitled to registration of the mark on the Principal Register under the rule of doubt, which the Examiner completely failed to address in her brief.

Applicant respectfully requests that the refusal to register the mark be reversed and that the mark be approved for publication for opposition purposes.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Amanda L. Stone', with a stylized flourish at the end.

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## TABLE OF AUTHORITIES

### **Cases**

*In re Benthin Mgmt. GmbH*, 37 U.S.P.Q.2d 1332, 1334 (T.T.A.B. 1995)

*In re Kahan & Weisz Jewelry Mfg.*, 508 F.2d 831, 184 U.S.P.Q. 421 (C.C.P.A. 1975)

*In re Standard Elektrick Lorenz Aktiengesellschaft*, 371 F.2d 870, 873, 152 U.S.P.Q. 563 (C.C.P.A. 1967)

### **Other Authorities**

J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION §13.30 (4th Ed. 2011)

TMEP § 1211.01